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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,159	10/09/2003	Laura Treibitz	22395 . 02	6452

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EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,159

Applicant(s)

TREIBITZ ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,11 and 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) ☐ Other: ____ |

DETAILED ACTION

1. This office action is in response to the Attorney's telephone call placed on 2/16/05 in regards to a question on whether the rejection was a 102 or a 103. The examiner has corrected the art rejection below.

Election/Restrictions

2. Applicant's election with traverse of Claims 2 and 7 in the reply filed on 9/26/05 is acknowledged. The traversal is on the ground(s) that he is entitled to a consideration of alternate related embodiments falling within the scope of a generic inventive concept and a search and examination of the entire application could be accomplished without a single burden on the Examiner since the embodiments would encompass a common field of search.. This is not found persuasive because MPEP Section 806.4 (e) states that Claims may be restricted to a single disclosed embodiment, or a claim may include two or more of the disclosed embodiments, hence making it a generic claim. MPEP Section 806.04(f) states that Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species. For these reasons the examiner has deemed that the applicant has presented multiple species in the claims and therefore the requirement for election of species is deemed proper. In response to Applicant's argument that the search and examination of the multiple embodiments would not cause a serious burden on the examiner, the examiner considers the fact

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that for each embodiment a new search would have to be done for each limitation, would need further search and examination, and each embodiment would need special consideration, therefore the examiner feels the search and examination to be a burden on the examiner, and therefore requirement for election is considered proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 7, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claims 2, 7 and 11: the phrase "extracting memento personalizing information from the database" is indefinite. This information was never entered into the database, it was only printed. Therefore it is unclear to the examiner how you can extract information from a database that was never entered into the database.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campell (US 2002/0077848).

7. With respect to Claims 1 and 6: Cambell discloses the use of a method ad software system accessed over the internet (See abstract) comprising the steps of:

- a. Inputting information relating to a stuffed toy (Paragraphs 0014 and 0018);
- b. Inputting the customer's personal identification information (Paragraphs 0015 and 0032);
- c. Inputting information related to designated recipient (Paragraphs 0015, 0020 and 0027); and
- d. Printing a personalized memento (Paragraph 0030).

8. Campbell discloses storing the information (allows a user to go back into the system at anytime and finish the book), but fails to disclose storing the information in a database. The way the information is stored is deemed to be nonfunctional descriptive limitation and is not functionally involved in the steps recited. The storing information steps would be performed the same regardless whether the information is stored in a file, or stored in a database. Thus this

descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

9. Claims 2, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Simas et al. (US 2003/0132966).

10. With respect to Claims 2 and 7: Campbell discloses obtaining a digital photo of the customer, formatting the memento to include the digital photo and printing the personalized memento with the photo (See Paragraphs 0016-0019). Campbell discloses this can be done at a mall at a kiosk (Paragraph 0017), but fails to disclose the use of the digital camera to take the photo of the customer. Simas discloses the use of a kiosk with a digital camera, that takes the customer's picture (Paragraph 0015). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Campbell to include a digital camera on the kiosk, as disclosed by Simas, in order to obtain the image on location (See Simas, Page 2).

11. With respect to Claim 11: Campbell discloses the use of a computer system comprising:

- e. A workstation computer comprising a processor, main memory, and a storage device (Paragraph 0017);
- f. A printer (Paragraph 0030);
- g. A computer program (Paragraph 0017);
- h. Means for inputting information such as toy, customer and recipient information (See Paragraphs 0017-0020, 0026);

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- i. Means for obtaining memento-personalizing information (See Paragraphs 0028-0030).

12. Campbell discloses the use of storing information, however, fails to disclose the use of a database for storing the personal information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Campbell to provide a database for storing information, since the examiner takes Official Notice that the use of databases for storing information is old and well known in the art, therefore it would be within the level of ordinary skill to use a database for storage.

13. Campell also fails to teach the use of a digital camera. Simas discloses the use of a kiosk with a digital camera, that takes the customer's picture (Paragraph 0015). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Campbell to include a digital camera on the kiosk, as disclosed by Simas, in order to obtain the image on location (See Simas, Page 2).

14. With respect to Claim 12: See Paragraphs 0005, and 0015-0017.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simpson (6,453,300) discloses the use of a personalized greeting card program, Mills (5,515,592) discloses the use of a personalized doll, Rappaport et al. (US 2003/0064812) discloses the use of smart cards in toys, Martha (Bee A Star Personalized Books and Gifts) discloses the use of making personalized books, and Moss (Dolls-Life History Collection) discloses personalized dolls.

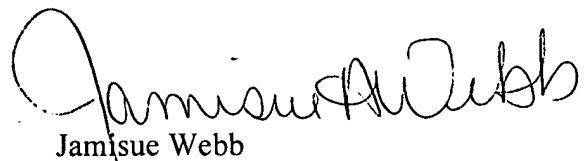
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jamisue Webb", is positioned above the printed name and title.

Jamisue Webb
Patent Examiner
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